UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,076	08/04/2005	John Kennedy	2883	7460

50855 7590 12/17/2009

Tyco Healthcare Group LP
60 MIDDLETOWN AVENUE
NORTH HAVEN, CT 06473

EXAMINER	
TENTONI, LEO B	
ART UNIT	PAPER NUMBER
1791	

MAIL DATE	DELIVERY MODE
12/17/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/530,076	KENNEDY ET AL.	
	Examiner	Art Unit	
	Leo B. Tentoni	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 October 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-18* is/are pending in the application.

4a) Of the above claim(s) *12 and 15-18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-11,13 and 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *07272009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 12 and 15-18 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 17 March 2008.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 2-8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roby et al (Roby I, U.S. Patent 6,191,236 B1) for the reasons of record.

5. Claims 9-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roby et al (Roby I, U.S. Patent 6,191,236 B1) as applied to claims 2-8 and 13 above, and further in view of Roby et al (Roby II, U.S. Patent 6,235,869 B1) for the reasons of record.

Response to Arguments

6. Applicant's arguments filed on 13 October 2009 have been fully considered but they are not persuasive.

7. Applicant argues (page 6) that Roby I does not disclose a process of making a monofilament suture from a block copolymer of about 50 to about 80% glycolide and about 20 to about 50% trimethylene carbonate. Instead Roby I discloses a process of making AB block copolymers wherein the A blocks include glycolide and the B blocks include two copolymerized p-dioxanone polymers (citing col. 2, lines 19-26 of Roby I). Examiner responds that Roby I teaches a block copolymer wherein the A block includes at least 50% glycolide and the remainder may be trimethylene carbonate (see col. 2, lines 27-36 of Roby I) and thus, Roby I meets the limitation of making a monofilament suture from a block copolymer of about 50 to about 80% glycolide and about 20 to about 50% trimethylene carbonate.

8. Applicant argues (pages 6 and 7) that Roby I does not disclose a process of making a monofilament suture wherein the

monofilament is drawn through a third oven at a temperature of about 120°C to about 140°C at a draw ratio of about 0.7:1 to about 0.8:1. Examiner responds that Roby I teaches a third oven temperature of 50 - 120°C (see Table I of Roby I) which meets the temperature limitation, and Roby I implicitly (or impliedly) teaches the third draw ratio range because (1) the instant claims use the term "about" which allows for some flexibility (or leeway) in the range (i.e., the upper range of the draw ratio may be larger than 0.8:1), (2) Roby I, like the instant process, teaches a third draw ratio that is less than 1 (i.e., Roby I teaches a third draw ratio range of 0.96:1 – 0.98:1), and (3) there is no disclosed criticality of the claimed third draw ratio range and where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover optimum or workable ranges by routine experimentation (MPEP 2144.05(II)(A)).

9. Applicant argues (pages 7 and 8) that Roby II fails to cure the deficiencies of Roby I, and that Roby II teaches away from block copolymers by differentiating the random copolymers of glycolide, caprolactone, trimethylene carbonate and lactide as exhibiting strength retention, mass loss and modulus similar to gut structures, unlike other known block copolymers (citing col. 1, lines 24-67 and col. 2, lines 58-62 of Roby II). Examiner responds that Roby II is cited for its disclosure of relaxing a monofilament suture during annealing, wherein the monofilament suture is made from polymers including glycolide and trimethylene

carbonate, and one of ordinary skill in the art would have a reasonable expectation of success in combining the relaxation/annealing step of Roby II in the process of Roby I since both Roby I and Roby II teach the use of glycolide and trimethylene carbonate polymers.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo B. Tentoni whose telephone number is (571) 272-1209. The examiner can normally be reached on Monday - Friday (6:30 A.M. - 3:00 P.M.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina A. Johnson can

be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leo B. Tentoni/
Primary Examiner, Art Unit 1791